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RECONSIDERATION   Serial No. 09/656,896

REMARKS

Claims 1 – 4, 6, 7, 9, 10, 12 – 17, 19, 20, 22, 23, 25 – 34, 36 – 38, and 40 – 44
remain in this application. Claims 1 and 4 are rejected for obviousness-type double
patenting. Claims 5, 8, 11, 18, 21, 24, 35 and 39 are previously canceled. The rejection
is respectfully traversed.

Claim 1 of this application is rejected under the judicially created doctrine of
obviousness-type double patenting as being patentable over claim 7 of related U.S. Patent
No. 6,892,303 to Le Pennec et al. in view of U.S. Pat. No. 6,094,731 Waldin et al. Claim
1 of Le Pennec et al. is asserted not to be patentably distinct from claim 4 of the present
application in view of Waldin et al. The double patenting rejection is respectfully
traversed.

> "[T]he analysis employed in an obviousness-type double patenting
> determination **parallels the guidelines for a 35 U.S.C. §103(a) rejection,**
> the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1,
> 148 USPQ 459 (1966), that are applied for establishing a background for
> determining obviousness under 35 U.S.C. 103 are employed when
> making an obvious-type double patenting analysis." MPEP §804(II)(B)(1)
> (emphasis added).

It is asserted that claim 1 of the present application is co-extensive with Le
Pennec et al. claim 7, except that Le Pennec et al. "does not discloses (sic) sending a
request to a file server for a virus-free certificate associated with a file ..., [the] request
... [including] requirements for said Virus-free certificate; and downloading the file and
the associated virus-free certificate," as recited by claim 1 of the present application.
Thus, it is asserted that Waldin et al. supplies what is missing from Le Pennec et al. in
that "[a] recipient computer 11, receives a file and digital signature attached to the file to
certify that the file is virus free (col. 5; lines 28-50, fig. 4)." The applicants note that
receiving a file is different from requesting a file. Be that as it may, however, it is

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asserted that "[t]he **step** of sending a request to the sending computer (server) **is obvious** …;" (emphasis added). 35 U.S.C. §103(a) provides in pertinent part that "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter **as a whole** would have been obvious at the time the invention was made" (emphasis added). Thus, the test for obviousness is the invention as a whole, i.e., claim 1 as a whole, not whether each individual element is obvious. Examining and finding each individual element obvious is improper. Therefore, an improper test for obviousness is being applied to find claim 1 obvious over Le Pennec et al. in view of Waldin et al.

> Any obviousness-type double patenting rejection should make clear: … (B) The **reasons why** a person of ordinary skill in the art would conclude that the invention defined in the claim ****>at issue would have been<** an obvious variation of the invention defined in a claim in the patent.
> When considering whether the invention defined in a claim of an application ***>would have been<** an obvious variation of the invention defined in the claim of a patent, **the disclosure of the patent may not be used as prior art.** >*General Foods Corp. v. Studiengesellschaft Kohle mbH,* 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992).<"
> MPEP §804(II)(B)(1) (emphasis added.)

It is further asserted with regard to claim 1 of the present application that, "downloading the file and the associated virus-free certificate, …" is disclosed by Waldin et al. in that "[Fig. 4, step 60 shows that the file and the attached signature is moved to recipient computer 11 i.e. downloaded, the virus free certificate is certified by a certificate authority (col. 4, lines 37-42]." From this, it is concluded that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use Waldin's teachings to modify the method of claim 7 of" Le Pennec et al. to result in claim 1 of the present application. Merely stating that it would have been obvious does not make it so, absent some suggestion to combine, a suggestion that arises from somewhere other than the two allegedly mutually obvious applications/patents. However, other than the above conclusory statement, no source is provided for the

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suggestion to combine. Accordingly, a *prima facie* case of obvious-type double patenting has not been made with respect to claim 1 of the present application.

Further, to support the finding of two-way obviousness-type double patenting, it is asserted that Le Pennec et al. claim 1 is not patentably distinct from the combination of Waldin et al. with claim 4 of the present application. However, in finding Le Pennec et al. claim 1 unpatentably obvious over claim 4, it is asserted that "**this application discloses, determining whether a virus-free certificate satisfies ... (p. 2; lines 7-8); receiving from file server (p. 2, lines 9-10), selecting form the list (p. 2, lines 11-12); and a virus-free certificate proxy (p. 3, lines 4-5).**" (emphasis added.) Thus, the present application is being used for the teaching, not claim 4. Clearly, here the application, which has been removed as a reference by 35 U.S.C. §103(c), is being applied improperly as prior art. The applicants acknowledge that the "specification can * be used as a dictionary to learn the meaning of a term in the patent claim." MPEP §804(II)(B)(1) (citations omitted.) Here, however, it is clear that the specification is not being used "to learn the meaning of a term in the patent claim;" but in lieu of claim 4. Thus, the specification is being used improperly in allegedly establishing double patenting.

Be that as it may, the Office action acknowledged that the present "application does not discloses (sic) identifying the file in a cache table, said cache table comprising for each identified file one or a plurality of virus-free certificates." For this, it is asserted that "Waldin discloses a proxy server (cache) that includes a list (table) of a plurality of anti virus programs (file) (col. 3, lines 57-61)." Waldin et al., col. 3, lines 57-61, provides that

> Antivirus scan module 3 can be a conventional antivirus product such as Norton AntiVirus (NAV). FIG. 1 illustrates a separate antivirus accelerator module 5 as performing the acceleration tasks of the present invention, and a separate authentication module 12 as performing the digital signature tasks of the present invention. Alternatively, modules 3, 5, and 12 could be combined into one module or two modules, and just as readily perform the scanning, acceleration, and authentication tasks of the present invention.

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Again, the applicants note that the test for obviousness is applied to "the invention as a whole," *supra*. Thus, for alleging double patenting, Le Pennec et al. claim 1, as a whole, must be obvious. The test is not whether each individual element, much less each word, is obvious. Moreover, a cache table of virus-free certificates is very different than a "proxy server ... that includes a list ... of anti virus programs." If examining and finding a single step obvious is improper, treating each word individually. as if the rest had no meaning within the context of the element, certainly is. The Office action further asserts that Waldin et al. discloses a "list of a plurality of virus-free certificates [that] belong to a virus-free certificate authority (col. 4, lines 37-42)." From this it is concluded that it "would have been obvious to one of ordinary skill in the art at the time the invention was made to use Waldin's teachings to modify the method of claim 4 of this application" to result in claim 1 of Le Pennec et al. Again, other than this conclusory statement, no source is provided for the suggestion to combine. Accordingly, a *prima facie* case of obvious-type double patenting has not been made with respect to claim 4 of the present application.

Therefore, because an improper test has been applied in finding obviousness-type double patenting, such that the claims have not been considered as a whole, but rather element by element or word by word; because the applications, rather than the claims themselves are being used in finding the teaching; and, because Waldin et al. is not the source for the suggestion to combine, a *prima facie* case of obvious-type double patenting has not been made. Reconsideration and withdrawal of the obvious-type double patenting rejection of the present application over Le Pennec et al. in view of Waldin et al. is respectfully solicited.

The applicants thank the Examiner for efforts, both past and present in examining the application. Believing the application to be in condition for allowance for the reasons set forth above, the applicants respectfully request that the Examiner reconsider and withdraw the obvious-type double patenting rejection and allow the application to issue.

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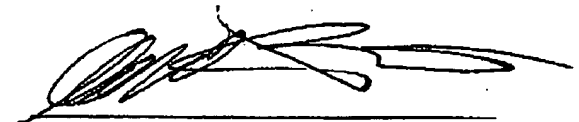
     Should the Examiner believe anything further may be required, the Examiner is
requested to contact the applicants undersigned attorney the local telephone number listed
below for a telephonic or personal interview to discus any other changes.

     Please charge any deficiencies in fees and credit any overpayment of fees to IBM
Corporation Deposit Account No. 50-0510 and advise us accordingly.

                                      Respectfully Submitted,

   October 26, 2005
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